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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,989	04/05/2001	Jed W. Fahey	046585/0138	4463

22428 7590 02/23/2007  
FOLEY AND LARDNER LLP  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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KRASS, FREDERICK F

ART UNIT	PAPER NUMBER
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1614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/825,989	<b>Applicant(s)</b> FAHEY ET AL.	
	<b>Examiner</b> Frederick Krass	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 48-63 and 65-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 48-51 is/are allowed.
- 6) ☒ Claim(s) 52,53,58-62 and 68-70 is/are rejected.
- 7) ☒ Claim(s) 54-57, 63, 65-67 and 71 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **Status of Case**

Unless specifically repeated infra, all previous rejections are withdrawn.

New grounds of rejection follow which were not necessitated by Applicant's amendment. Accordingly, this action is NON-FINAL.

### **Written Description Rejection**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 52, 58-62 and 68-70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification sets forth assays for screening plants to identify those that are "rich" in glucosinolates, i.e., those having high Phase II enzyme-inducing potential (= at least 200,000 units per gram fresh weight of Phase II enzyme-inducing potential). See page 3, lines 7-26, and page 17, lines 5-11. The state of the art (even after the filing date of the instant application), however, is such that one skilled in the art would expect same

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only in cruciferous plants. See USP 6,991,811 at the passage bridging column 1, line 59 to column 2, line 10. Nowhere does the instant specification specify which particular plant genera have high Phase II enzyme-inducing potential, other than cruciferous plants.<sup>1</sup> Accordingly, the mere disclosure of an assay which is potentially useful for discovering other plant genera having these desired characteristics does not place such additional genera in applicant's possession; instead, it merely represents a "wish or plan" for doing so. See Univ. of Rochester v. G.D. Searle, 69 USPQ2d 1886 (CAFC 2004); see also Univ. of Cal. v. Eli Lilly, 119 F.3d 1559, 1568 (Fed. Cir. 1997).

This position is also consistent with earlier precedent holding that the activity of plant extracts is unpredictable beyond individual genera. See In re Sichert, 196 USPQ 209 (CCPA 1977). Furthermore, it is reflected in the observation that USP 6,991,811, which employed an assay substantially similar to that disclosed by applicant (see column 2, lines 11-23 of the prior art), was able to discover only one additional plant genera (*Echinacea*) high in phase II enzyme-inducing potential, and then only within certain extract fractions.

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<sup>1</sup> The examiner interprets the language used in instant claims 53 and 63 as reciting cruciferous seeds, cruciferous plants, or cruciferous plant parts, i.e., a recitation of alternative members within a Markush group.

### **Indefiniteness Rejection**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 52 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "rich" in claim 52 is a relative term which renders the claim indefinite. The term "rich" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

As used in the instant claims and specification, the term "rich" is essentially meaningless. No limiting definition of the term appears to be provided; instead, the specification uses the term in very loose and general fashion. Note for instance the description at page 1, line 24 of plants "extremely rich" in glucosinolates. Since no definition of "rich" is ever provided, it is impossible to determine what substantive difference there is between "rich" and "extremely rich" (and by implication "poor" in glucosinolates).

### **Allowable Subject Matter**

Claims 48-51 remain allowable as presently advised.

Claims 54-57, 63, 65-67 and 71 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick Krass whose telephone number is (571) 272-0580. The examiner can normally be reached at (571) 272-0580 on Monday through Friday from 9:30AM to 6:00PM.

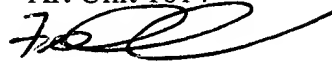
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached at (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frederick Krass  
Primary Examiner  
Art Unit 1614

A handwritten signature in black ink, appearing to be 'F. Krass', written over the printed name.